

Appl. No. 10/629,990
Amdt. dated August 12, 2004
Reply to Office Action of May 20, 2004

REMARKS/ARGUMENTS

Applicants acknowledge receipt of the Office Action dated May 20, 2004. Claims 12-19 and 22-36 are pending in the application. The Examiner has allowed claims 12-19 and 25-36. Claim 24 is objected to by the Examiner. The Examiner has rejected claims 22 and 23 under 35 U.S.C. § 102 as being anticipated by Hebert et al., U.S. Patent No. 5,878,818 ("*Hebert*"). Applicants believe that all pending claims are allowable over the art of record and respectfully request reconsideration.

I. Claims 22 and 23 are not anticipated by *Hebert*.

Applicants respectfully traverse the Examiner's rejection of claims 22 and 23 under 35 U.S.C. § 102 as being anticipated by *Hebert*. Applicants submit that the claims are not anticipated by *Hebert* because *Hebert* fails to disclose each and every limitation of these claims.

Claim 22 is an independent claim upon which claim 23 depends. Claim 22 recites "setting the reference member within the cased borehole; then setting the anchor member in the cased borehole." Nothing in *Hebert* teaches or suggests setting a reference member and then setting an anchor member. Instead, *Hebert* teaches first setting an anchor member and then using a whipstock that is attached to the anchor member to further set the anchor member. Applicants respectfully point out that *Hebert* does not teach setting the whipstock and then setting the anchor member. For instance, *Hebert* teaches a sidetracking assembly having a starter mill, whipstock and an anchor. (*Hebert*, col. 4, lns. 22-25). The lower end of the whipstock is threadably engaged with the upper end of the anchor. (*Hebert*, col. 5, lns. 11-13; Fig. 1B). When the sidetracking assembly

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is lowered into a borehole and reaches a desired depth, *Hebert* teaches that slips in the anchor member are actuated and engage with the casing, "thereby anchoring the mechanical set anchor in place within the cased wellbore." (*Hebert*, col. 4, lns. 27-30; col. 5, lns. 61-65). When the anchor is set, *Hebert* teaches that a ledge on the starter mill strikes a shoulder on the whipstock that is threadably engaged with the anchor, which further sets the slips of the anchor into the casing. (*Hebert*, col. 5, ln. 66-col. 6, ln. 6). Nowhere in *Hebert* is setting a reference member and then setting an anchor member taught or suggested.

In view of the recitations in claim 22 that are neither taught nor suggested by *Hebert*, the Applicants respectfully request that the Examiner withdraw the § 102 rejection and allow claim 22. Applicants further request that the Examiner also withdraw the § 102 rejection of dependent claim 23, since it is submitted that independent claim 22 is allowable. Dependent claim 23 must *a fortiori* also be allowable, since it carries all the limitations of the independent claim to which it ultimately refers.

II. Claim 24 is allowable.

The Examiner has objected to claim 24 as "being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." (Office Action, pg. 3, first paragraph). Applicants respectfully submit that claim 24 is allowable as independent claim 22 to which it depends is also submitted to be allowable. Therefore, Applicants respectfully request the Examiner to withdraw the objection to claim 24.

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III. Conclusion

Applicants respectfully request reconsideration, allowance of the pending claims and a timely Notice of Allowance be issued in this case. The Examiner is respectfully requested to contact the undersigned if the Examiner feels that a telephone conference would expedite the resolution of this case.

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the prior art that have yet to be raised, but which may be raised in the future.

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If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Conley Rose, P.C. Deposit Account Number 03-2769.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Tod T. Tumey', written over a horizontal line.

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